

REMARKS

Claims 1, 3-5, 8-17, 28, 30 and 37-46 are now pending in the application, with claims 1, 28, 42 and 46 being the independent claims. Reconsideration and further examination are respectfully requested.

In the Office Action, objection was made to claim 7 because the word “to” appeared in quotation marks. The cancellation of claim 7 above renders this objection moot.

Claims 1-36 were rejected under 35 USC § 112, second paragraph, for failing to recite active, positive steps limiting how the “auxiliary criterion” is used. The amendments above clarify that the auxiliary criterion is used for addressing email messages to a group of recipients (independent claims 1 and 42, together with their dependent claims) or for sorting email messages (independent claims 28 and 46, together with their dependent claims). These recited steps clearly are active and positive. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1-36 were rejected under 35 USC § 101 for failing to produce a useful, tangible and concrete result. In response, the claims have been amended above to recite the addressing and sending of an email message (independent claims 1 and 42, together with their dependent claims) or the sorting of email messages (independent claims 28 and 46, together with their dependent claims). Both results clearly are useful, tangible and concrete. Accordingly, withdrawal of this rejection is respectfully requested.

In addition, claims 28 and 29 were rejected under § 101 for reciting a computer-readable medium. In particular, the Office Action asserts that the specification language in paragraph [51] which refers to “an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, system, device, propagation medium, or computer memory,” could be said to

encompass signals or carrier waves. However, the language itself clearly only encompasses physical media and devices that include such instructions, as does the expression “computer-readable medium” itself. In any event, independent claim 28 has been amended above to clearly recite that the medium stores the recited process steps, and corresponding changes have been made to dependent claim 30. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1-14 and 18-36 were rejected under 35 USC § 102(a) over U.S. Patent Application Publication No. 2003/0200265 (Henry); and claims 15-17 were rejected under § 103(a) over Henry. Withdrawal of these rejections is respectfully requested for the following reasons.

Independent claim 1 has been amended above by incorporating features of dependent claims 2, 6 and 7, and those dependent claims have been canceled above. In addition, certain textual changes have been made to improve the organization of claim 1 and to clarify the recited features. Support for these amendments is provided in the Specification, e.g., at Paragraph [15] (“Criteria can be used to quickly form an email group”); Paragraph [16] (“This allows a criterion such as ‘all employees who are managed by Susan Smith’ to be used in addressing . . . email operations.”); Paragraph [32] (“Thus, queries that include relational combinations of standard and additional characteristics can be used for addressing...”); Paragraph [33] (“Another use of the additional information is to create custom email groups. For example, a group can be defined that includes email users whose office is in building 1U, and who are not part of the RIT project’.”); Paragraphs [36]-[38] and Figure 2; and Paragraph [47] (entire paragraph).

Generally speaking, independent claim 1 (and corresponding independent claim 42) are directed to techniques for allowing a user to flexibly defying a group of email recipients. As

discussed in more detail in the Specification, in the past, an email group generally could only be defined by manually selecting individual email addresses to be included within the group.

In contrast, the present invention as recited in independent claims 1 and 42 allows a group to be defined by an auxiliary criterion which uses information in addition to information in an email address. Thus, for example, as described more fully in the Specification, a user might identify the group as all individuals within a specified geographic location that work on a particular project. In certain representative embodiments, the identification of the group involves accessing external databases, either within the organization or even from a different organization.

More specifically, independent claims 1 and 42 are directed to the addressing of an email message. At least one auxiliary criterion is defined by accepting a signal from a user input device to at least partially define the at least one auxiliary criterion. The auxiliary criterion uses information in addition to information in an email address, and is used to identify a group of email addresses. The email message is then sent to the email addresses within the identified group.

The foregoing combination of features is not disclosed or suggested by the applied art. For example, Henry does not disclose or suggest at least the feature of sending an email message to a group of recipients that have been identified based on an auxiliary criterion that uses information in addition to information in an email address.

In this regard, the only portion of Henry cited in the Office Action as relating to groups is paragraph [0037] of Henry. However, that portion of Henry only talks about identifying a single email recipient. For example, paragraph [0037] of Henry repeatedly references the “intended *recipient*”. Although paragraph [0037] of Henry contemplates that the identification information provided by the user might result in multiple matches, paragraph [0038] of Henry clearly states

that the user then selects from among those potential matches in order to designate the correct intended recipient.

In other words, Henry allows a user to identify an intended email recipient by supplying information other than just the email address. However, Henry says nothing at all about identifying groups of recipients to whom an email message should be sent.

For at least this reason, independent claims 1 and 42 are believed to be allowable over the applied art.

New claim 37 depends from independent claim 1, and new claim 44 depends from independent claim 42. Each recites the additional feature that the signal from the user input device comprises a text string including a relational expression that defines the group. This feature of the invention is supported, e.g., at Paragraph [37] of the Specification and, particularly in combination with the other features of the corresponding base claim, is not believed to be disclosed or suggested by the applied art.

New claim 38 depends from independent claim 1, and new claim 45 depends from independent claim 42. Each recites the additional feature that the group is generated automatically based on a query. This feature of the invention is supported, e.g., at Paragraphs [07] and [47] of the Specification and, particularly in combination with the other features of the corresponding base claim, is not believed to be disclosed or suggested by the applied art.

New claim 39 depends from claim 8 and recites the additional feature that the external database includes a human resource database. This feature of the invention is supported, e.g., at Paragraphs [16] and [26] of the Specification and, particularly in combination with the other features of claims 1 and 8, is not believed to be disclosed or suggested by the applied art.

New claim 40 depends from claim 8 and recites the additional feature that the external database includes a facilities database. This feature of the invention is supported, e.g., at Paragraph [16] of the Specification and, particularly in combination with the other features of claims 1 and 8, is not believed to be disclosed or suggested by the applied art.

New claim 41 depends from independent claim 1 and recites the additional feature that the defining, using and sending steps are performed by an email client. This feature of the invention is supported, e.g., at Paragraph [44] of the Specification and, particularly in combination with the other features of claim 1, is not believed to be disclosed or suggested by the applied art.

Independent claims 28 and 46 are directed to the sorting of email messages. Initially, an auxiliary criterion selected by a user is accepted, the auxiliary criterion using information in addition to a format of an email. The auxiliary criterion is then used to sort email messages.

As noted above, claim 28 has been amended to recite positive, concrete and tangible steps. Support for the amendments to claim 28 can be found, e.g., at Paragraphs [15], [18] and [34] of the Specification. New independent claim 46 corresponds to claim 28.

The foregoing combination of features is not disclosed or suggested by the applied art. For example, Henry is not seen to say anything at all about sorting email messages based on any auxiliary criterion.

For at least this reason, independent claims 28 and 46 are believed to be allowable over the applied art.

The other rejected claims in this application depend from the independent claims discussed above, and are therefore believed to be allowable for at least the same reasons.

Because each dependent claim also defines an additional aspect of the invention, however, the individual reconsideration of each on its own merits is respectfully requested.

In order to sufficiently distinguish Applicants' invention from the applied art, the foregoing remarks emphasize several of the differences between the applied art and Applicants' invention. However, no attempt has been made to categorize each novel and unobvious difference. Applicants' invention comprises all of the elements and all of the interrelationships between those elements recited in the claims. It is believed that for each claim the combination of such elements and interrelationships is not disclosed, taught or suggested by the applied art. It is therefore believed that all claims in the application are fully in condition for allowance, and an indication to that effect is respectfully requested.

If there are any fees due in connection with the filing of the currently submitted papers that have not been accounted for in this paper or the accompanying papers, please charge the fees to Deposit Account No. 08-2025. If an extension of time under 37 C.F.R. 1.136 is required for the filing of any of the currently submitted papers and is not accounted for in this paper or the accompanying papers, such an extension is requested and the fee (or any underpayment thereof) should also be charged to the Deposit Account.

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Respectfully submitted,  
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